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PATENT APPLN. NO. 10/593,483
RESPONSE UNDER 37 C.F.R. § 1.116

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REMARKS

Claims 1-4, 6, and 9-11 are rejected as being anticipated under 35 U.S.C. § 102(b) by Higashikawa et al., U.S. Patent No. 5,851,200 ("Higashikawa"). Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Higashikawa in view of Hughes, US Patent 6,554,792. Claims 7-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Higashikawa in view of Michaels, US Patent 5,685,846.

These rejections, to be proper, require that Higashikawa disclose each of the elements, i.e., limitations of claim 1 of the application. However, contrary to the allegation in the Final Action, Higashikawa does not disclose a pre-filled syringe which meets the limitations of claim 1 that "an axial length of the intermediate gasket is longer than that of the bypass, and when an axial length of the bypass is a_1 and an axial effective length of the seal part is b_1 , $a_1 > b_1$."

First, regarding the limitation that the axial length of the intermediate gasket is longer than that of the bypass, Higashikawa discloses in Col. 17, lines 8-9, that bypass groove has been previously proposed in PCT/JP94/2138. Page 1/12 of the drawings of PCT/JP94/2138 shows that the bypass groove has an axial length that is longer than the gasket, or sliding valve. Page 1/12 of the

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drawings of PCT/JP94/02138 is attached hereto for the convenience of the Office.

Moreover, to function as a bypass in Higashikawa, the bypass groove must necessarily be longer than the "intermediate gasket" 91. Gasket, or valve, 91 in Higashikawa includes a pair of annular lips at each end which are in contact with the inner surface of the cylinder straight portion 88 and seal the medicines in the cylinder. If the valve 91 is longer than the bypass groove as suggested by the Office, the groove cannot act as a bypass because one set of annular lips will always be in contact with and seal the inner surface of the cylinder straight portion as the valve is advanced in the axial direction and passes the bypass groove. I.e., as the front set of annular lips advances beyond the opening of the bypass, the rear set of annular lips will be in contact with the inner surface of the cylinder and seal the cylinder and when the front set of lips reaches and advances beyond the closing of the bypass, the front set of lips will be in contact with the inner surface of the cylinder and seal the cylinder.

The bypass can only act as a bypass in Higashikawa if the axial length of the valve, or gasket, is shorter than that of the bypass.

Therefore, the syringe of Higashikawa does not meet the

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limitations of the claims of the present application that that the axial length of the intermediate gasket be longer than that of the bypass and cannot support the anticipation of the claims.

The syringe of Higashikawa also does not meet the limitation of claim 1 that when an axial length of the bypass is a_1 and an axial effective length of the seal part is b_1 , $a_1 > b_1$. In Higashikawa, the seal part of the gaskets, e.g., valves 90 and 91, comprises both pair of annular lips at the ends of the valves. The seal part of the valves 90 and 91 cannot be properly construed as being only one pair of the annular lips.

Removal of the 35 U.S.C. § 102(b) rejection of 1-4, 6, and 9-11 is in order. Additionally, since Higashikawa does not support the anticipation of claim 1, it cannot properly support the 35 U.S.C. § 103(a) rejections of the claims that depend, directly or indirectly, on claim 1. Removal of the 35 U.S.C. § 103(a) rejections is also in order.

The foregoing is believed to be a complete and proper response to the Office Action dated July 20, 2009, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

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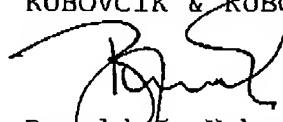
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In the event that this paper is not considered to be timely filed, applicants hereby petitions for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

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Attachment: Page 1/12 of the drawings of PCT/JP94/02138

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